

REMARKS

I. Restriction/election

The Office issued a restriction requirement that divides the claimed subject matter into the following three groups:

I. Claims 1-3 (in part), 5-8 (in part), 9-10 and 13-17 (in part), drawn to benzo[1,3]oxazin (i.e. Y₂ = N, Y₃ = C, Y₄ = O, and U₅ = U₆ = U₈ = C);

II. Claims 1-3 (in part), 5-8 (in part), 11-12 and 13-17 (in part), drawn to chromene (i.e. Y₂ = Y₃ = C, Y₄ = O, and U₅ = U₆ = U₈ = C);

III. Claim 1 (in part), 4, 5-7 (in part) and 13-17 (in part), drawn to others.

On September 22, 2004 Applicant's agent Mr. Claude Purchase by telephone provisionally elected Group I, claims 1-3 (in part), 5-8 (in part), 9, 10, and 13-17 (in part) with traverse. Applicant hereby affirms the election.

II. Amendments to Claims

Claims 1- 17 are pending in the application as filed.

Claims 4, 11, and 12 are cancelled for being drawn to non-elected invention, not for any reason related to patentability.

Claim 15 is cancelled for purpose of expediting the prosecution of the application. Applicant intends to pursue the subject matter in continuing applications.

Claim 16, which originally depends from claim 15, is converted to an independent claim.

Claims 1, 7, 8, 14, and 17, are amended to delete non-elected subject matter.

In addition, claim 1 is amended to delete the terms "Substituted 3- to 6-membered heterocycloalkyl-(G)_m" and "Substituted 5- or 6-membered heteroaryl-(G)_m," where each of which was recited as a substituent for the substituted R₁ and R₂ groups in the claim as filed. The amendment is intended to better define the invention.

Claim 14 is also amended to change its dependency from claim 12 to claim 13. This amendment is to correct a typographical error, where the base claim that claim 14 was intended to depend from was incorrectly recited as claim 12.

Claims 18 and 19 are added, both of which depend from original claim 16. Support for new claims 18 and 19 are found in the claims and specification as filed, such as claim 16 and page 71 of the specification.

Claims 1-3, 5-10, and 13, 14, and 16 -19 are pending in the application after entry of this amendment.

Applicant does not intend by these or any amendments to abandon any subject matter of the claims as originally filed or later presented. The Applicant reserves the right to pursue the subject matter not currently pursued in continuing applications.

III. Remarks

A. Claim Rejections - 35 U.S.C. §112, First Paragraph

Claim 15 is rejected under 35 U.S.C. §112, first paragraph, on the alleged basis that the specification is not enabled for the entire scope of the claim. In order to expedite the prosecution of the application, Applicant has cancelled claim 15.

B. Claim Rejections - 35 U.S.C. §112, Second Paragraph

Claims 1-3, 5-10 and 13-17 are rejected under 35 U.S.C. §112, second paragraph as being indefinite. Claim 1 is an independent claim, from which the remaining rejected claims depend. The alleged basis for rejecting claim 1, as well as claims dependent therefrom, is that the term "substituted" is indefinite. Specifically, the Office asserts that "applicants fail to articulate by chemical name, structural formula or sufficiently distinct functional language, the particular moieties applicants regard as those which will facilitate substitution, requisite to identifying the composition of matter claimed."

The term "substituted" is found in the definitions of R¹ and R² in claim 1 as amended. The specific substituents intended to effectuate the substitution and manner of the substitution for the substituted R¹ and R² groups are provided by chemical name, structural formula, or sufficiently distinct functional language in claim 1 as originally filed (at line 25 on page 127 through line 7 on page 128), as well as the specification as originally filed (on pages 5, 6, 43, and 44). Thus, the term "substituted" in claim 1 and claims dependent therefrom is clear and definite.

The Examiner further alleges that in claim 1 or elsewhere the phrase "cycloalkyl-(C₁-C₈ alkylene); . . . phenyl-(C₁-C₈ alkylene) . . . Naphthyl-(C₁-C₈ alkylene)" is not clear. Applicant believes that the meaning of each of these terms is clear as they each have been specifically defined in the specification. Specifically, the definition of "phenyl-(C₁-C₈ alkylene)" is found at line 29 on page 58 through line 2 on page 29,

which incorporates the definition of "(C₁-C₈ alkylenyl)" provided on line 27 on page 56 though line 2 on page 57; definition of "naphthyl-(C₁-C₈ alkylenyl)" is found at lines 10-13 on page 59, which incorporates both the definition of "(C₁-C₈ alkylenyl)" provided at line 27 on page 56 though line 2 on page 57, and the definition of "naphthyl" provided on line 9 on page 59; and, finally, definition of "cycloalkyl-(C₁-C₈ alkylenyl)" is seen on page 57 at lines 10-13 (for "C₃-C₆ cycloalkyl-(C₁-C₈ alkylenyl") and lines 19-21 (for "C₅ or C₆ cycloalkyl-(C₁-C₈ alkylenyl"), both incorporating the definition of "C₁-C₈ alkylenyl" provided at line 27 on page 56 though line 2 on page 57.

For the above reasons, Applicant believes that the rejection to claim 1 as amended, as well as its dependent claims 2, 3, 5-10, and 13-17, should be withdrawn. In addition, new claims 18 and 19 ultimately depend from claim 1. For the same reasons as provided for claim 1 above, Applicant believes that claims 18 and 19 are clear and definite.

The Examiner also indicates that in claim 10 (page 135) the nomenclature of the two species "benzo[1,3]oxaxin-4-one" is incorrect. Applicant, who agrees with the Examiner, wishes to point out that this is a typographical error. Claim 10 has been amended to recite the correct nomenclature "benzo[1,3]oxazin-4-one" as suggested by Examiner.

C. Concluding Remarks

In view of the above amendments and remarks, Applicant respectfully requests reconsideration of the application, withdrawal of the rejections, and timely issuance of Notice of Allowance.

Respectfully submitted,

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